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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/577,765  | 04/28/2006  | Hironu Izumida       | 052363-0033         | 6932             |
| 20277 7590 01/02/2009<br>MCDERMOTT WILL & EMERY LLP<br>600 13TH STREET, N.W.<br>WASHINGTON, DC 20005-3096 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| ZHU, WEIPING  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1793  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 01/02/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,765

**Applicant(s)**

IZUMIDA ET AL.

**Examiner**

WEIPING ZHU

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-7 and 9 are currently under examination, wherein no claim has been amended and claim 9 has been newly added in applicant's amendment filed on November 14, 2008.

### ***Status of Previous Rejections***

2. The previous rejections of claims 1-7 under 35 U.S.C. 103(a) and the previous rejections of 1-7 on the ground of nonstatutory obviousness-type double patenting as stated in the Office action dated August 28, 2008 are maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izumida et al. (US Pub. 2004/0099354 A1).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izumida et al. (US Pub. 2004/0099354 A1) as stated in the Office action dated August 28, 2008.

With respect to the new claim 19, it is a process limitation in a product claim. Even though the claimed product is limited by and defined by the process, determination of patentability is based on the product itself. Izumida et al. ('354 A1)

discloses a steel wire (claim 1), which reasonably appears to be only slightly different than the respective claimed products in claim 1. A rejection based on section 103 of the status is eminently fair and acceptable. See MPEP 2113.

4. Claims 1-7 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 of U.S. Patent No. 7,404,865 B2.

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 of U.S. Patent No. 7,404,865 B2 as stated in the Office action dated August 28, 2008.

With respect to the new claim 19, the reason for the rejection as stated in the paragraph above is applied properly herein.

#### ***Response to Arguments***

4. The applicant's arguments filed on November 14, 2008 have been fully considered but they are not persuasive.

The applicant argues that the drawing ratios disclosed by Izumida et al. ('354 A1) (paragraph [0029]) are completely different from those of the instant invention, therefore the desired texture as claimed in the instant claim 1 cannot be obtained and that the rejections of the instant claims 1-7 under 35 U.S.C. 103(a) and on the ground of nonstatutory obviousness-type double patenting as stated in the Office action dated August 28, 2008 are not legally viable. In response, see the ground of rejection of the new claim 19 as stated above. The examiner notes that the claimed and Izumida et al. ('354 A1)'s steel wire are identical or substantially identical in structure or composition

and are produced by identical or substantially identical processes, therefore a prima facie case of obviousness exists. The same volume percents of martensite phase and austenite phase and same x-ray diffraction intensity ratios would be expected in the steel wire of Izumida et al. ('354 A1) as in the claimed steel wire. The application of the In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) and MPEP 2112.01 [R-3] I as the ground of the rejection of the claim limitation of microstructure feature and x-ray diffraction intensity ratios as stated in the Office action dated August 28, 2008 is proper and maintained.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

WZ

12/22/2008

**Application Number****Application/Control No.**

10/577,765

**Examiner**

WEIPING ZHU

**Applicant(s)/Patent under  
Reexamination**

IZUMIDA ET AL.

**Art Unit**

1793